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Paper No. 20
TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pacific Solar Company, Inc.
v.
Pacific Solar Pty., Ltd.

Cancellation No. 30,378

Carla B. Oakley of Brobeck, Phleger & Harrison for
Pacific Solar Company, Inc.

Gary J. Nelson of Christie, Parker & Hale for Pacific
Solar Pty., Ltd.

Before Simms, Seeherman and Quinn, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Pacific Solar Company, Inc. has petitioned to cancel
a registration owned by Pacific Solar Pty., Ltd. for the
mark shown below



for "solar cell panels used for converting sunlight into electricity."¹ As grounds for cancellation, petitioner asserts priority and likelihood of confusion under Section 2(d) of the Trademark Act. More specifically, petitioner asserts that respondent's mark, when applied to respondent's goods, so resembles petitioner's previously used trade name and trademark PACIFIC SOLAR for solar power systems comprising photovoltaic modules, batteries, battery charge regulators, wiring harnesses, voltage regulators, inverters and structural hardware, and for design and technical consultation services for others in the field of solar electric systems, as to be likely to cause confusion.

Respondent, in its answer, denied the salient allegations in the petition for cancellation.

The record includes the pleadings; the file of the involved registration; trial testimony, with related exhibits, taken by petitioner; photocopies of petitioner's two pending applications,² and respondent's

¹ Registration No. 2,258,341, issued July 6, 1999, alleging a claim of priority under Section 44(d) of the Act based on Australian application no. 657,908, filed April 6, 1995, which issued as registration no. 657,908.

² Application Serial Nos. 75/402,205 and 75/402,206 to register the mark PACIFIC SOLAR for, respectively, "solar electric systems design, and consulting and installation services" (alleging first use and first use in commerce in October 1991) and "solar electric systems and components" (alleging first use

responses to certain of petitioner's interrogatories and requests for admissions,³ all introduced by way of petitioner's notices of reliance.⁴ Respondent neither took testimony nor introduced any other evidence. Both parties filed briefs.⁵ An oral hearing was not requested.

in December 1991 and first use in commerce in April 1992). After respondent's registration was cited as a bar to registration under Section 2(d) of the Trademark Act, action on the applications was suspended pending the final disposition of this cancellation proceeding.

³ Petitioner filed, on the same day, two notices of reliance on its requests for admissions. In one, petitioner essentially asserts that respondent failed to timely respond to the requests for admission and that, therefore, the requests stand admitted. In the other notice of reliance, petitioner alternatively relies upon the requests expressly admitted by respondent, namely, nos. 8, 11, 13, 19 and 20.

The Board, in an order issued June 4, 2001, granted respondent's motion to extend its time to respond to discovery and ruled that "the discovery responses which have since been served upon petitioner are hereby deemed timely." In view thereof, we do not view the requests for admissions as deemed to be admitted, and we have given no consideration to the notice of reliance relying on each and every one of the requests for admissions. Rather, in reaching our decision, we have considered only the ones specifically relied upon by petitioner where respondent filed express admissions.

⁴ Petitioner further filed a notice of reliance on the declaration of Chuck Whitaker, an officer of a third party in the industry. Respondent objected to the improper submission in its brief. Trademark Rule 2.123(b) provides that testimony in the form of an affidavit or declaration may be submitted, but only pursuant to a written agreement of the parties. There is no written agreement here, and Mr. Whitaker's declaration does not form part of the evidentiary record. Accordingly, this evidence has not been considered.

⁵ Petitioner, in its reply brief, objects to certain portions of respondent's brief, contending that these portions are not supported by any evidence of record. The Board generally will not strike a portion of a brief upon motion by an adverse party which simply objects to the contents thereof. Rather, any objections which an adverse party may have to the contents of such a brief will be considered by the Board in its determination of the case, and any portions of the brief which

Before turning to the substantive issues of priority and likelihood of confusion, we will consider the evidentiary objections made in respondent's brief on the case. In its brief on the case, respondent expended a great deal of effort (nine pages) in making objections to petitioner's evidence. As we pointed out earlier, we have not considered the Whitaker declaration or any of the requests for admission not expressly admitted. Respondent also objects to all of the exhibits introduced during the deposition of Marianne Walpert, petitioner's founder and co-owner, and to the one exhibit introduced during the testimony of Maurice Miller, petitioner's co-owner, vice president and treasurer. These hypertechnical objections are overruled essentially for the reasons set out in petitioner's brief. Simply put, we see no deviation by petitioner relative to Trademark Rule 2.123(f)(2).

Respondent makes a myriad of other objections to various testimony and exhibits. The objections relate to relevancy, proper foundation, hearsay, and the like. Although petitioner, in its reply brief, specifically

are found by the Board to be improper will be disregarded. TBMP § 540. Suffice it to say that to the extent respondent's brief contains factual statements which are not supported by properly submitted evidence, the statements have not been considered. BL

responded to each of the objections, we see no reason to do the same, essentially for the reason that we generally agree with petitioner's arguments made in response. Accordingly, we have considered all of petitioner's testimony and evidence (except to the extent indicated earlier), and have accorded it whatever probative weight it merits.

STANDING

The first issue we need to address is petitioner's standing. Respondent raised lack of standing as a defense in its answer, and respondent reiterates the point in its brief. The essence of this defense is that "petitioner does not have standing because petitioner cannot prove that Marianne Walpert assigned her rights in the 'PACIFIC SOLAR' name to petitioner prior to the filing of the petition to cancel." (brief, p. 28).

According to the testimony of Ms. Walpert, she began business activities under the mark PACIFIC SOLAR as a sole proprietorship in California in 1991. In October 1991, her business under the mark was certified as a New York State Woman-Owned Business Enterprise. Pacific Solar, in April 1994, was certified by the state of California as a "Disadvantaged Business Enterprise and

Women Business Enterprise." In November 1997, petitioner, Pacific Solar Company, Inc., was incorporated under the name PACIFIC SOLAR in the state of California. We find that the record establishes that the petitioner corporation owned the mark, by virtue of a transference of title, prior to the filing of the petition for cancellation, and that the petitioner corporation owns the applications that have been rejected under Section 2(d) on the basis of respondent's registration.

Ms. Walpert testified that it was her intention, when she incorporated Pacific Solar Company, Inc. in 1997, to transfer all of the assets of the sole proprietorship to the corporation and that, to the best of her knowledge, that was what happened. (dep., p. 141). Mr. Miller testified that "it was a material part of the bargain that Pacific Solar Company['s] trademark and trade name be transferred to the new company." (dep., p. 15)

The corroborating document evidencing the transfer (Miller dep., ex. 1) has spawned a dispute between the parties. Respondent contends that the document is "suspicious" and, at one point in its brief, characterizes the document as "fraudulently generated."

The document is captioned "Assignment and Assumption Agreement" between the assignor Pacific Solar Company, a sole proprietorship, and the assignee, Pacific Solar Company, Inc., a California corporation. The agreement is signed by Ms. Walpert and indicates that it is "made and entered into as of the 1st day of January 1998." The transferred assets specifically include the PACIFIC SOLAR trademark.

Although Ms. Walpert's recollection of her signing of the agreement is imperfect, it clearly was her intention to transfer rights in the mark to the petitioner corporation. Even absent the written agreement, the uncontroverted testimony evidences the transfer. The document, regardless of the date of execution, merely confirms the transfer. See: Huang v. Tzu Wei Chen Food Co. Ltd., 849 F.2d 1458, 7 USPQ2d 1335, 1336 (Fed. Cir. 1988), citing American Manufacturing Co. v. Phase Industries, Inc., 192 USPQ 498, 500 (TTAB 1976) ["[n]either a formal assignment nor recordation of an assignment in the Patent and Trademark Office is necessary to pass title or ownership to common law or statutory trademark rights"].

The evidence also establishes that petitioner is the actual owner of the two applications made of record and

that petitioner's pending applications have been refused registration under Section 2(d) on the basis of respondent's registration. Such facts prove petitioner's standing. See: Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Apart from the above, petitioner's commercial interest in the use of the identical mark is sufficient to confer standing. Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

PRIORITY

We next address the issue of priority of use. The parties agree that the earliest date upon which respondent may rely in this case is April 6, 1995 (i.e., the Section 44(d) priority filing date). Respondent has admitted that it has made no actual use in commerce to date.

Ms. Walpert began business under the name PACIFIC SOLAR as a sole proprietorship in California in 1991. According to Ms. Walpert, her business was responsible for the design, assembly and installation of one of the first two grid-connected solar electric systems in California in 1993. Components of the completed system bore the PACIFIC SOLAR mark. In the years to follow, Ms. Walpert continued to design, assemble and install solar

electric systems under the mark PACIFIC SOLAR. Ms. Walpert estimated her proprietorship's gross income in 1993 as \$100,000, and in 1994 in the range of \$20,000-\$50,000. Ms. Walpert testified about a "number of proposals that went out in '92, '94 time period, a couple to the Sacramento Municipal Utilities, one to PG & E, one to the south coast air quality management board in southern California, and I don't remember if they were exactly in 1993, but that that was the time range they were going out, as well as smaller residential proposals during that time frame." (dep., pp. 59-60) The business, according to Ms. Walpert, also was selling parts under the PACIFIC SOLAR mark.

Also of record is testimony and related exhibits pertaining to Ms. Walpert's involvement with the development of a solar roof rack for motor vehicles in 1991-1992. One such electric car was equipped with a PACIFIC SOLAR solar roof rack.

The record further includes examples of use in promotion of the mark in connection with Ms. Walpert's services. Ms. Walpert has distributed business cards (ex. No. 36) throughout the years at industry conferences and meetings, and the cards were included in correspondence and sales efforts. Each business card

prominently displayed the PACIFIC SOLAR mark and the term "photovoltaic systems." Beginning in 1992, Ms. Walpert distributed brochures to potential customers, as well as to the general public at solar home tours and alternative energy fairs.

Ms. Walpert has placed advertisements bearing the PACIFIC SOLAR mark in trade publications. The record includes specific advertisements placed in Northern California Sun (a publication of The Northern California Solar Energy Association) in the years 1993-1996.

We find petitioner's testimony to be sufficiently probative and satisfactory to establish its priority of use of PACIFIC SOLAR as a trademark and as a trade name. Further, the record includes corroborative exhibits. See: *Powermatics, Inc. v. Globe Roofing Products Co., Inc.*, 341 F.2d 127, 144 USPQ 430 (CCPA 1965). Given respondent's inaction at trial, petitioner's record stands un rebutted. Although respondent, in its brief, has gone to great lengths to critique much of the evidence of record, whether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether petitioner has established prior use by a preponderance of the evidence. In the words of our primary reviewing court, we "should

look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use." As instructed by the court, we must recognize the clear interrelationship existing between the several pieces of evidence and consider each piece of evidence in light of the rest of the evidence, rather than individually. *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

When the record is examined in such a manner, it is clear that the testimony and evidence as a whole demonstrate that petitioner has priority of use of PACIFIC SOLAR in connection with solar energy goods and services.

LIKELIHOOD OF CONFUSION

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In *re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the

goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*,
544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Insofar as the marks are concerned, respondent has admitted that its mark is "extremely similar in sight, sound and meaning to petitioner's marks and petitioner's trade name." (Request for Admission No. 13) Petitioner has established prior use of the marks PACIFIC SOLAR per se and PACIFIC SOLAR with an ocean wave design. Each of these marks is substantially similar to respondent's mark. In terms of sound, the literal portions of the parties' marks are identical. Further, as to connotation, the marks convey substantially similar, if not identical, meanings, namely, that the goods and/or services involve solar energy along the Pacific Ocean coast. Finally, with respect to appearance, the literal portion of respondent's mark is identical to the entirety of petitioner's PACIFIC SOLAR mark, and is identical to the literal portion of petitioner's logo mark. Although respondent's mark includes a design feature, respondent's mark, as well as petitioner's logo mark, clearly is dominated by the literal portion PACIFIC SOLAR. Although we must compare marks in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular

feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Because the literal portion of a mark is used to call for the goods and/or services, it is likely to dominate over any design portion of the mark. Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A., 32 USPQ2d 1192, 1197 (TTAB 1994).

Turning next to the goods and/or services, petitioner has established prior use of its marks in connection with design, consultation and installation services involving solar electric systems, and with solar electric systems, including components such as solar panels. The involved registration lists respondent's goods as "solar cell panels used for converting sunlight into electricity." In correspondence between Ms. Walpert and Dr. Paul Basore, deputy research director, manufacturing, for respondent, Dr. Basore indicated that the parties "share similar visions regarding the proliferation of roof-mounted grid-interactive PV [photovoltaics] systems." (Walpert dep., ex. no. 48)⁶

⁶ In the same email dated December 22, 1997, Dr. Basore wrote: "You've come to my attention again, this time because it seems that the company I now work for in Australia chose essentially

In comparing petitioner's goods and services with respondent's goods, we start with the premise that they need not be identical or even competitive to support a holding of likelihood of confusion. It is sufficient that the goods and services be related or that conditions surrounding their marketing are such that they are encountered by the same persons who, because of the relatedness of the goods and services and the similarities between the marks, would believe mistakenly that the goods and services originate from or are in some way associated with the same producer. *Hercules Inc. v. National Starch and Chemical Corp.*, 223 USPQ 1244, 1247 (TTAB 1984).

It is clear that the parties' goods overlap and that petitioner's services in the solar energy field are closely related to respondent's solar energy goods. Further, it would appear that the parties' goods and services are intended for the same classes of purchasers, namely environmentally concerned individuals and companies. While some of these purchasers are likely to

the same company name as you are currently using. They did this before I joined the company, and were not aware of the existence of your company at the time. The issue has come to the forefront now because we tried to register the name PacificSolar as an internet domain address and discovered that you already have it." The communication then broached the subject of possible resolutions to the conflict.

be sophisticated when it comes to buying a solar energy product, it is apparent that not all of the goods are expensive, and that they would also be purchased by ordinary individuals for use in their homes. In any event, given the virtual identity between the marks and the goods and services, even sophisticated purchasers likely would be confused.

Another du Pont factor in this case is actual confusion. Mr. Miller testified that actual confusion between the parties' marks "has occurred on many occasions," and then went on to cite three examples. One instance involved misdirected mail, and the other two involved mistaken identity (i.e., individuals thought that petitioner was, in fact, respondent). Ms. Walpert testified generally that, at conferences, attendees have confused the two companies. Ms. Walpert went on to detail one example of misdirected mail. Although the record does not include the testimony of those confused, it is clear that the instances of confusion are a direct result of the parties' use of the identical mark PACIFIC SOLAR in connection with solar energy goods and services. This factor weighs in favor of petitioner.

Petitioner asserts that its mark is strong and well known in the industry. Although we find petitioner's

mark to be inherently distinctive (albeit suggestive), suffice it to say that the record falls short of proving that the mark is well known. Thus, we have not treated the factor of fame as favoring petitioner.

We conclude that purchasers familiar with petitioner's solar energy goods and services sold under petitioner's previously used PACIFIC SOLAR marks would be likely to believe, upon encountering respondent's mark PACIFIC SOLAR and design for solar cell panels, that the goods and services originate with or are somehow associated with or sponsored by the same entity.

Decision: The petition for cancellation is granted. Registration No. 2,258,341 will be canceled in due course.